

REMARKS

Applicants respectfully request the Examiner to reconsider the present application in view of the foregoing changes to the specification and claims.

Status of the Claims

In the present Reply, claims 6 and 19 have been amended, and claim 14 has been canceled without prejudice or disclaimer of the subject matter contained therein. Claims 1-5 and 10-13 and 15-18 were previously canceled without prejudice or disclaimer of the subject matter contained therein. Thus, claims 6-9 and 19 are pending in the present application.

No new matter has been added by way of these amendments, because each amendment is supported by the present specification. For example, the amendment to claim 6 may be found in the present specification at least at page 3, lines 17-22 and/or pending claim 19. With the amendment to claim 6, claim 19 was appropriately amended and actually deletes subject matter. Thus, no new matter has been added.

Based upon the above considerations, entry of the present amendments is respectfully requested.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Issues Under 35 U.S.C. § 102/103

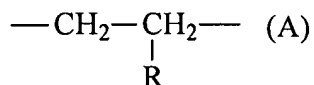
Claim 6 is rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Babu et al. '164 (U.S. Patent 5,559,164) (see paragraph 2 of the Office Action).

Also, claims 7-9, 14 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Babu '164 (see paragraph 4 of the Office Action).

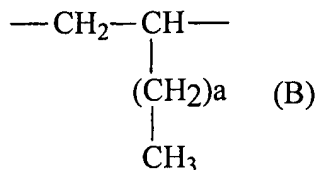
Applicants respectfully traverse, and reconsideration and withdrawal thereof are respectfully requested.

Distinctions over Babu '164 (Paragraph 3 of the Office Action)

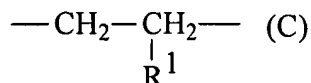
Babu '164 discloses (1) one or more of copolymers and α -olefins of which 90.1 to 99 mol percent are one or more straight chain α -olefins having 2 to 10 carbon atoms, of which at least 55% have 6 to 10 carbon atoms, and 9.9 to 0.1 mole percent are one or more α -olefins having 6 to 20 carbon atoms and at least one methylidyne (see, e.g. the Abstract). More specifically, the Babu copolymer is that described at column 3, lines 1-49. That is, in the Babu copolymer, when



is the propylene unit, its content is 0 to 30 % (mole). Also at column 3 of Babu '164,



("a" is an integer from 3 to 7) is an α -olefin having 6 to 10 carbon atoms (for example, 1-hexene, 1-heptene, 1-octene, 1-nonene, 1-decene) and its content is 60.1 to 99.9% (mole). Further, the Babu copolymer has a content of



at 0.1 to 9.9% (mole) (see especially lines 1-13 of column 3 of Babu '164).

However, the copolymer as used in the claimed adhesive contains propylene at 20 to 99 mole % (1 to 80 mol% for the vinyl compound (I)). And in contrast to the Babu '164 copolymer, the instantly claimed copolymer does not contain an α -olefin having 6 to 10 carbon atoms (B) as a major component, which is the major component (content: 60.1 to 99.9 mole %) in the copolymer of Babu '164 (disclosed in column 3 as discussed above). Therefore, the copolymer used in the adhesive of instantly pending claim 6 is completely different from the copolymer (1) disclosed in Babu '164.

Accordingly, because "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," Applicants respectfully submit that the cited Babu '164 reference cannot be a basis for a rejection under § 102(b). See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631,

2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Thus, because of the lack of disclosure of all features as instantly claimed, the rejection in view of Babu '164 is overcome. Reconsideration and withdrawal are respectfully requested.

With regard to the rejection under § 103(a) and paragraph 3 of the Office Action, Applicants respectfully submit that this rejection has been overcome as well. In this regard, U.S. case law squarely holds that a proper obviousness inquiry requires consideration of three factors: (1) the prior art reference (or references when combined) must teach or suggest all the claim limitations; (2) whether or not the prior art would have taught, motivated, or suggested to those of ordinary skill in the art that they should make the claimed invention (or practice the invention in case of a claimed method or process); and (3) whether the prior art establishes that in making the claimed invention (or practicing the invention in case of a claimed method or process), there would have been a reasonable expectation of success. *See In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991); *see also In re Kotzab*, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000); *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988). Here, not even the initial requirement of disclosure of all instantly claimed features has been satisfied. Thus, the rejection under § 103(a) (paragraph 3 of the Office Action) has been overcome as well.

Applicants add that the cited Babu '164 reference fails to teach, recognize or suggest the use of the α -olefins having 6 to 10 carbon atoms (B) used as a major component in copolymer (1). Thus, one of skill in the art would not be motivated or reasonably expect to be successful in achieving the present invention upon reading the disclosure in Babu '164, whereas the skilled

artisan would have to omit the α -olefins having 6 to 10 carbon atoms (B) in the reference's copolymer. In this regard, the claimed invention or combination cannot change the principle of operation of the cited reference or render the reference inoperable for its intended purpose. *See* M.P.E.P. §§ 2143.01, 2145(III). Applicants add that as the Federal Circuit has held: "If references taken in combination would produce a 'seemingly inoperative device,' we have held that such references teach away from the combination and thus cannot serve as predicates for a prima facie case of obviousness." *See McGinley v. Franklin Sports Inc.*, 60 USPQ2d 1001, 1010 (CAFC 2001) (citing *In re Sponnoble*, 405 F.2d 578, 587, 160 USPQ 237, 244 (CCPA 1969) (references teach away from combination if combination produces seemingly inoperative device) and *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (inoperable modification teaches away)). Thus, Applicants respectfully submit that the requisite motivation and/or reasonable expectation of success are lacking as well. *In re Vaeck; McGinley; Gordon*. Reconsideration and withdrawal of the rejection under § 103(a) are respectfully requested.

Distinctions over Babu '164 (Paragraph 4 of the Office Action)

Claim 14 has been canceled herein, thus rendering moot the rejection of claim 14. With regard to pending claims 7-9 and 19, these claims depend on claim 6. Thus, in this regard, Applicants respectfully submit that the above arguments apply to this rejection as well and submit that claim 6 cannot be rejected, as noted above. Therefore, the rejections of claims 7-9 and 19 are

also rendered moot and/or have been overcome. Reconsideration and withdrawal of this rejection (paragraph 4 of the Office Action) are respectfully requested..

Conclusion

A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case.

If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to contact Eugene T. Perez (Reg. No. 48,501) at the offices of Birch, Stewart, Kolasch & Birch, LLP.

Application No.: 10/024,244

Docket No.: 2185-0602P


Art Unit 1713

Response to Non-Final Office Action dated April 13, 2005

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Dated: July 11, 2005

Respectfully submitted,

By 

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